

REMARKS

I. Status of Claims

After the above amendments, claims 1-17, 19-21 and 23-31 are pending. Claims 1, 19, 20 and 30 are independent with claims 28-31 being newly added. While Applicant respectfully disagrees that any claim amendments are required in view of the outstanding rejections, Applicant has made clarifying amendments to claims 1, 19, and 20 in an effort to further prosecution. Further, various additional clarifying amendments have been made.

II. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,539,635 issued to Larson, Jr. (hereafter LARSON) in view of U.S. Patent No. 5,136,636 issued to Wegrzynowicz (hereafter WEG).

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). As stated in MPEP § 2143.03, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Regarding amended claim 1, Applicant respectfully submits that neither LARSON nor WEG, alone or in combination, teaches or suggests that:

**said received user related broadcast identifier is not
required to identify by itself said at least one radio or
television broadcast provider**

The closest teaching of the above identified feature is found in LARSON which discloses a radio program distribution system that is adapted to interact with a customer through a telephone to facilitate the purchase of radio program content that the customer heard on the radio. As part of the telephonic interaction, LARSON's radio program distribution system receives certain items of information from the customer in order to locate a data entry in a

database that corresponds to a radio program the customer wishes to purchase. The items of information include time, date and broadcaster. Once received by the radio program distribution system, the system uses the three items of information to find a corresponding entry in a Broadcast Table (shown in Fig. 3). Once the corresponding entry in the Broadcast Table is located a Reference Tag is obtained. The Reference Tag is then used to find a corresponding entry in a Program Table (shown in Fig. 2) which contains information about the radio program the customer is inquiring about.

In LARSON's radio program distribution system, the system requires that the information received from the customer include all three items of information, namely the time, date and broadcaster. The system will only have a single entry in the Broadcast Table for any given combination of time, date and broadcaster. Herein, the broadcaster directly corresponds to a radio broadcaster that broadcasts radio programs. With respect to the broadcaster information received from the customer, LARSON teaches that either the broadcaster identity is received from the customer or the customer selects the broadcaster identity through a menu. In either case, when the customer provides the broadcaster identity to the system, the provided broadcaster identity by itself identifies the broadcaster. Since the broadcaster identity by itself identifies the broadcaster, the system uses the exact broadcaster identity provided by the customer to locate the appropriate entry in the database.

Accordingly, LARSON provides no mechanism to allow for the receipt of a broadcaster identifier from the customer that does not identify by itself the broadcaster. If LARSON's system received a broadcaster identifier that does not identify by itself the broadcaster, the system will not be unable to locate an entry in the database since there will be no direct match between the received broadcaster identity and the broadcaster identity used in the database. Therefore, LARSON fails to teach that "said received user related broadcast identifier is not required to identify by itself said at least one radio or television broadcast provider" as recited in amended claim 1. Further, WEG fails to make up for LARSON's deficiencies that are addressed above.

Moreover, Applicant respectfully submits that the combination of LARSON and WEG fail to teach or suggest the following features recited in claim 1:

communicating said user related geographic identification code into said database to create a subset of data, said subset of data comprising at least one of said stored broadcast identifiers that are associated with said user related geographic identification code

There is no teaching or suggestion in either LARSON or WEG for the above identified features of communicating a user related geographic identification code into a database to create a subset of data. This issue has been previously addressed by both Applicant and the Examiner. For example, on page 7 of the final rejection, the Examiner has asserted that the above subject matter is taught by WEG which teaches "that based on the ANI of the calling party (which reads on claimed geographical ID), the system connects the customer to the database that contains providers that correspond to the customer's geographical area." In other words, the above cited portion of WEG teaches routing the customer to a second database that contains dealers in the same local area as the instant customer. However, in the amendment filed August 23, 2006 and again herein, Applicant's submit that WEG's routing function is not a teaching or suggestion of creating a subset of data.

In particular, the function of WEG's primary database is to route the caller information to a secondary database that contains telephone numbers relating to "a dealer in the same local area" as the caller. The initial look-up by the primary database does not "create a subset of data" but rather uses NPA (caller's telephone area and exchange code) to **look-up** "a number for identifying the secondary database" (WEG Col. 2, lines 49-53) it should also be noted that this number is not a telephone number. Further, the primary database does not create the number for identifying the secondary database. Instead, the primary database looks-up and provides the number for identifying the secondary database. Therefore, at best, WEG's primary database looks up information that is used for routing instead of creating a subset of data.

In response to the above argument presented in the amendment filed August 23, 2006, the Examiner on page 3 of the final rejection has identified a different element in WEG that allegedly teaches the above subject matter. In the final rejection, the Examiner has argued that when the caller's NPA is received, the "DSD 150 database" (secondary database)..." uses the routing number to find a segment of its database that contains the required translation information." (Col. 5, lines 20-30). In other words, the Examiner is arguing that finding an item

of information in a database corresponds to creating a subset of data. However, this portion of WEG fails to teach creating a subset of data for the same reasons presented above with respect to the primary database. Thus, even if WEG's secondary database were considered, there is no "subset of data created." Therefore, contrary to the Examiner's allegation, WEG does not teach "communicating said user related geographic identification code into said database to create a subset of data, said subset of data comprising at least one of said stored broadcast identifiers that are associated with said user related geographic identification code."

Additionally, Applicant respectfully submits that the Examiner's combination of LARSON and WEG fails to teach or suggest the following features recited in claim 1:

identifying at least one radio or television broadcast provider using at least both said subset of data and said user related broadcast identifier

There is no teaching or suggestion in either LARSON or WEG for the above identified feature. This issue has been previously addressed by the Applicant on pages 7 and 8 of the amendment filed August 23, 2006. The Examiner is encouraged to reconsider the previously submitted arguments in addition to the arguments presented below.

The Examiner alleges that the Applicant's above identified feature is taught by LARSON. In particular, the Examiner is interpreting LARSON's selection of a database entry, for a Broadcast ID entered by a customer, as reading on the Applicant's above identified feature. However, in LARSON, the selection of a database entry, for a Broadcast ID entered by a customer, is nothing more than a matching function and is not in any way an identification function. In particular, the Broadcast ID that is entered by the customer is representative of a particular broadcast provider *already known to the customer*. The broadcast program distribution system receives the Broadcast ID that is entered by the customer, along with time and date information, to find database entries associated with the Broadcast ID. Since the Broadcast ID entered by the customer already fully represents a particular broadcast provider, an identification function does not need to be performed. Therefore, contrary to the Examiner's allegation, LARSON does not teach an identification function, let alone "identifying at least one radio or television broadcast provider using at least both said subset of data and said user related broadcast identifier."

Furthermore, Applicant asserts that the Examiner's obviousness determination is based on impermissible hindsight reconstruction, and not on the objective teachings of LARSON and WEG. Applicant submits that even if one were to combine LARSON and WEG, the resulting combination would not arrive at the present invention.

The particular combination of LARSON and WEG implemented by the Examiner is a modification of LARSON per WEG to include a technique for sorting broadcasters based on their geographical location. As motivation for the combination, the Examiner has asserted that the combination would have been obvious for "the improvement of allowing customer's to dial a single '1-800' number, but to access providers that are local to the customer." Applicant agrees that WEG provides the above motivation but respectfully disagrees that it motivates the particular combination set forth by the Examiner. In particular, WEG does not in any way teach a technique for sorting broadcasters based on their geographical location or area of broadcast signal. Instead, WEG is concerned with the routing of a customer's telephone call to one of a plurality of local providers' telephone numbers. In WEG, customer's use their telephone to dial a toll-free telephone number that is common to all of the participating providers (dealers). Further, each provider has their own telephone number that services the customer's location. Accordingly, Applicant asserts that one of ordinary skill in the art would not combine LARSON and WEG to arrive at the Applicant's claim 1 without using hindsight reconstruction.

"When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." Id. at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)). In the present case, if one considers LARSON and WEG as a whole, the resulting combination becomes clear. Based on WEG's teaching, one of ordinary skill in the art would at best be motivated to apply WEG in a scenario in which it is desired to use a single telephone number to route a call to one of a plurality of local providers that each have their own telephone number. The only portion of LARSON related to the dialing of a telephone number is a customer's dialing of a broadcast program distribution system's telephone number to purchase a particular broadcast program that was heard while listening to a broadcast signal. In the context of WEG, LARSON's broadcast program distribution system is nothing more than a service provider with a telephone number.

Therefore, the modification of LARSON per WEG would at best yield a system in which customers are given a "1-800" number to be routed to one of a plurality of broadcast program distribution systems, each having their own telephone number.

The above combination of LARSON and WEG significantly differs from that set forth in the Examiner's combination. Instead, the Examiner's combination appears to be a combination of select portions of LARSON and WEG that are divorced from their teaching and suspiciously fit together so as to formulate something that resembles the Applicant's claim 1. In picking out and combining the chosen portions of LARSON and WEG, the Examiner has not given any indication or suggestion as to how or why the particular portions are selected by the Examiner to be detached from their respective teachings. Furthermore, the Examiner has not identified or suggested how one might blend all of the various concepts in LARSON and WEG. Accordingly, it is clear that the Examiner's combination fails to consider the objective teachings of the prior art as a whole and instead uses the Applicant's teaching as a roadmap for picking and choosing isolated elements from LARSON and WEG to formulate something that resembles the Applicant's claim 1. Therefore, it is clear that the Examiner's combination can only be based on impermissible hindsight reconstruction.

Accordingly, for any of the reasons presented above, claim 1 is allowable over the cited references and withdrawal of the rejection is earnestly solicited. Since claims 2-17, 28 and 29 depend from claim 1, and since LARSON and WEG do not disclose all of the limitations of claim 1, applicant submits that claims 2-17, 28 and 29 are patentable at least by virtue of their dependency from claim 1.

In addition, claim 30 comprises similar subject matter to that discussed above with respect to claim 1 and are therefore allowable for similar reasons. Also, since claim 31 depend from claim 30, and since LARSON and WEG do not disclose all of the limitations of claim 30, Applicant submits that claim 31 is patentable at least by virtue of its dependency from claim 30.

Regarding claim 19, Applicant respectfully submits that the claim includes certain features and operations that are analogous to those discussed above with regard to claim 1, which Applicants have shown to be allowable. For example, claim 19 recites that the:

user inquiry comprises a user related broadcast identifier that is not required to identify by itself said at least one broadcast provider

Accordingly, Applicant respectfully submits that LARSON and WEG fail to teach or suggest the above identified feature for the same reasons as those presented above with respect to claim 1. Further, Applicant respectfully submits that for the same reasons as those presented above with respect to claim 1, the Examiner's obviousness determination is based on impermissible hindsight reconstruction and not the objective teachings of LARSON and WEG. Still further, issues related to claim 19 have been previously addressed by the Applicant on pages 10 and 11 of the amendment filed August 23, 2006. The Examiner is encouraged to reconsider the previously submitted arguments. Accordingly, Applicants submit that claim 19 is allowable over the cited references and withdrawal of the rejection is earnestly solicited.

Regarding claim 20, Applicant respectfully submits that the claim includes certain features and operations that are analogous to those discussed above with regard to claim 1, which Applicants have shown to be allowable. For example, claim 20 recites that the:

said received broadcast identifier is not required to identify by itself said at least one radio or television broadcast provider

Accordingly, Applicant respectfully submits that LARSON and WEG fail to teach or suggest the above identified feature for the same reasons as those presented above with respect to claim 1. Further, Applicant respectfully submits that for the same reasons as those presented above with respect to claim 1, the Examiner's obviousness determination is based on impermissible hindsight reconstruction and not the objective teachings of LARSON and WEG. Still further, issues related to claim 20 have been previously addressed by the Applicant in prior submissions. The Examiner is encouraged to reconsider the previously submitted arguments. Accordingly, Applicants submit that claim 20 is allowable over the cited references and withdrawal of the rejection is earnestly solicited. Also, claims 21 and 23-27 depend from claim 20, and since

LARSON and WEG do not disclose all of the limitations of claim 20, Applicant submits that claims 21 and 23-27 are patentable at least by virtue of their dependency from claim 20.


III. Conclusion

In view of the above, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

It is believed that no additional fees are due in connection with the filing of this Amendment. However, in the event of any variance between the fees determined by Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance, including any extension of time fees and new claims fees to the undersigned's **Deposit Account No. 50-0206**.

Respectfully submitted,

Date: September 14, 2007



Raymond B. Persino
Reg. No. 58,082
Attorney for Applicant

HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W. Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)